

## REMARKS

This Amendment is submitted in response to the Office Action dated October 31, 2007, having a shortened statutory period set to expire January 31, 2008. In the present Amendment, Claims 22-42 are now pending. Claims 22, 23, 29, 30, 36, and 37 have been amended.

### I. Claim Rejection Under 35 U.S.C. § 103

#### General requirements for a claim rejection under 35 U.S.C. § 103

According to 35 U.S.C. § 103(a):

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To make the obviousness determination, the U.S. Supreme Court held in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) that three factors must be considered:

- (1) the scope and content of the pertinent prior art;
- (2) differences between the pertinent prior art and the invention at issue; and
- (3) the ordinary level of skill in the pertinent art.

The U.S. Supreme Court clarified in *KSR Intern. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 that a non-obviousness determination must include an inquiry as to “whether the improvement is more than the predictable use of prior art elements according to their established functions.” Also, the Court in *KSR* stated that:

[I]t will be necessary for the court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having the ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

However, the Court in *KSR* emphasized that “the analysis [of non-obviousness] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a

court can take into account of the inferences and creative states that a person of ordinary skill in the art would employ”.

**A. Rejection of Claims 22-42 under 35 U.S.C. § 103(a)**

In the present Office Action, Claims 22-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tormey et al.* (U.S. Pub. No. 2005/0071239 – hereinafter referred to as “*Tormey*”) in view of *Greenwood* (U.S. Patent No. 6,675,212 – hereinafter referred to as “*Greenwood*”). After careful consideration of Examiner’s rejection, Applicants assert that Claims 22-42, as now amended, are not rendered unpatentable by the combination of *Tormey* and *Greenwood* in view of the arguments herein.

**1. Rejection of independent Claims 22, 29, and 36**

**a. Scope and content of the prior art**

*Tormey* discloses utilizing a web-based search engine and receiving a listing. *Tormey*, paragraph 5, lines 7-9 and Figure 1A, reference number 20, paragraph 43, lines 1-22, and paragraph 44, lines 1-2. *Tormey* also discloses allowing a user to elect the receipt of the search results via an e-mail message. *Tormey*, paragraph 83.

*Greenwood* discloses a system and method for improving data browsing efficiency in computer implemented data browsing systems. *Greenwood*, col. 3, lines 51-52. The invention enables automatic continuation of a data browsing session when a download of a requested data file is temporarily delayed. *Greenwood*, col. 3, lines 53-55. In particular, data requests are monitored for excessive delay. *Greenwood*, col. 3, lines 55-57. The reasonable time frame for determining a temporary delay is separately programmable by the user. *Greenwood*, col. 7, lines 42-46. When the delay is identified as temporary, the download of the requested data file is handled by a separate monitoring task, set to run in the background, while active control of the data browsing session is returned to a user. *Greenwood*, col. 3, lines 58-62.

**b. Differences between the prior art and the claimed invention**

Applicants have amended exemplary Claim 22 (and as similarly applied to Claims 29 and 36) to include the elements of:

    sending a request for a first file from a communication program;  
    detecting whether an option to forward from said communication program a received first file to a mail server has been activated;  
    in response to said activated option, a data processing system waiting a user increment period before detecting whether said first file is received;  
    in response to said first file not being received, said communication program determining whether a predetermined length of time specified in response to a timeout query has expired; and  
    in response to determining a predetermined length of time specified in response to said timeout query ~~from when said request is sent~~ has expired, and upon receipt of said first file by said communication program, said communication program encapsulating said first file in a message transmission and redirecting sending said message transmission to said mail server, wherein said mail server is responsive to a mail request by a mail client containing a target address.

Support of the amendments can be found in the present Specification, paragraph [0031], *et seq.* and Figure 3, reference numbers 304, 310, 312, and 314. Upon further review of Examiner's references, Applicants respectfully submit that nothing in the combination of *Tormey* and *Greenwood* discloses or suggests "in response to said activated option, a data processing system waiting a user increment period before detecting whether said first file is received; in response to said first file not being received, said communication program determining whether a predetermined length of time specified in response to a timeout query has expired;," as recited in exemplary amended Claim 22.

At most, the combination of *Tormey* and *Greenwood* shows a system that enables a user to perform a search on a web-based search engine while monitoring for a reasonable time whether a response to a data request has been received. *Greenwood*, col. 7, lines 42-43.

In contrast, exemplary Claim 22, recites two distinct and separate time periods that are measured: (i) a user increment period, and (ii) an amount of time provided in response to a timeout query. Support for this assertion can be found in Applicants' present Specification, paragraph [0033]:

“Returning to block 304, if the option to forward response 132 to mail server 104 is detected, the process next moves to step 310, which depicts data processing system 102 waiting during a period, called a user increment, for receipt of response 132. The user increment is a length of time, separate from and generally shorter than, but potentially identical to the amount of time provided in response to timeout query 210.” (emphasis added)

Upon review of *Tormey* and *Greenwood*, nothing in the combination would suggest to a person with ordinary skill in the art to employ creative states or inferences that would lead to Applicants’ invention as recited in amended exemplary Claim 22. First, by Examiner’s own acknowledgement, *Tormey* makes no explicit teaching of a time period (see page 3 of Office Action). Second, while *Greenwood* teaches a “reasonable time” frame to wait for a response (*Greenwood*, Col. 7, lines 29-46), such teaching falls short of teaching or even suggesting two separate time periods as recited in Applicants’ amended claims: (i) a user increment period, and (ii) an amount of time provided in response to a timeout query. Therefore, in view of the aforementioned arguments, Applicants submit exemplary independent Claim 22, similar independent Claims 29 and 36, and all dependent claims are not rendered unpatentable by the combination of *Tormey* and *Greenwood* under 35 U.S.C. § 103(a). Applicants respectfully request that the rejection be withdrawn.

## **2. Rejection of dependent Claims 23-28, 30-35, and 37-42**

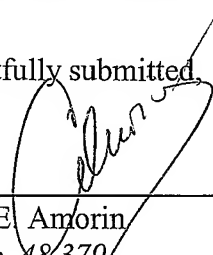
Applicants have amended dependent claim 23 (and similarly amended Claims 30 and 37) to more clearly recite that: “in response to determining said predetermined length of time specified in response to said timeout query has not expired, and upon receipt of said first file by said communication program, displaying said first file by said communication program.” Support of these amendments can be found in Applicants’ Specification, paragraph [0035].

Moreover, Applicants respectfully submit that all dependent claims are allowable at least by virtue of their dependence upon an allowable base claim.

## **II. CONCLUSION**

No extension of time for this response is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application to **IBM Corporation Deposit Account Number 09-0447**.

Respectfully submitted,



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